

## REMARKS

Claim 144 has been amended to correct the error noted by the Examiner.

There are three independent method claims, 126, 128, and 129, and three corresponding independent system claims, 138, 142, and 145.

Independent method claim 128 and its corresponding system form claim 142 are rejected under §103 as unpatentable over Johnson (US 5,991,876). With respect to the point of novelty of claim 128, the Examiner is misreading Johnson. Johnson does not teach or suggest that a person could place an order for a “copy” of a work of authorship. The only deliverables for which a person might place an order, as taught by Johnson, are “rights”. The “rights” that may be ordered in the system taught by Johnson are so intangible that they have no embodiments. There is no “copy” of any right that may be ordered. The “right” is actually a release by a copyright holder in favor of the person to whom the right is granted, so that the licensee can not be successfully sued by the copyright holder for infringement of copyrights, provided certain limitations on the “right” are followed.

Johnson makes clear that the only properties offered by the system are rights and not copies. In column 3, Johnson states: “A second enhancement is the inclusion of an order table to provide a dynamic log of right authorizations and denials.” (Emphasis added) In column 8 lines 15 - 20 Johnson states “during the first year of the contract, rights are offered at a base fee ... . During the second year of the contract, rights are offered at a base fee of ... .”

Details of the ordering capabilities of the system are discussed in column 9 beginning at line 35 where Johnson states that the order table “provides a dynamic log of right authorizations and denials”. At lines 45 - 48 Johnson states: “Order\_right field 448 contains a reference or link to a right\_instance field 410 of rights table 408. This link identifies the right ordered.” (Emphasis added)

In column 10 at lines 42 - 45, Johnson states “User interface 700 includes a view of a constructive index card 702 to specify a particular right for which authorization is sought.” (Emphasis added)

At the bottom of page 3 of the most recent office action, the Examiner asserts that Johnson teaches: "The clearinghouse server system processes the order for a copy of the work of authorship for printing on paper", citing figure 7, column 7 lines 40 - 55, column 8 lines 1 - 22, column 9 lines 35 - 55, and column 10 lines 40 - 60. This reading of Johnson by the Examiner is incorrect.

Figure 7 does not teach that the system may offer, or a user may place, an order for "a copy of the work of authorship". Figure 7 teaches that, when a prospective licensee requests a license, the licensee may be required to specify whether the type of use will be on paper or electronic and the number of copies that the licensee wishes to make. Figure 7 does not teach that a user of the server system may place an order for a copy to be delivered, in any form, or that the server system is capable of delivering a copy in any form.

In column 7 at lines 40 - 55, Johnson explains that the type of use for which a prospective licensee may seek permission may be specified, such as educational, not for profit, commercial, on paper, in an optical memory, in a computer memory serving an intranet, or in a computer memory serving the internet. This paragraph in Johnson does not teach either that a prospective licensee can place an order for a copy of a work of authorship or that the system could be made capable of delivering a copy of a work of authorship.

In column 8 at lines 1 - 22 Johnson discusses the rights table which holds information about rights granted. Again, the granting of a right is not the delivery of a copy. It is not the delivery of anything. Although the price to be paid by the prospective licensee as discussed in this paragraph of Johnson may vary according to the number of copies that the licensee is authorized to make, this section of Johnson does not teach that the prospective licensee may place an order for someone else to make the copies or that the server system may provide copies.

The applicant has discussed Johnson at column 9 lines 35 - 55 above. To recapitulate, this paragraph of Johnson merely teaches that "rights" can be ordered, not that copies can be ordered.

In column 10 at lines 40 - 60, Johnson discusses the user interface through which a prospective licensee will place an order for rights. When the prospective licensee

places the order, the licensee may be required to specify whether the use will be made on paper or electronically and the number of copies that the user will make. This paragraph of Johnson does not teach either that the prospective licensee may place an order for copies or that the server system can deliver copies.

In the recent office action on page 4 at the beginning of the concluding paragraph, the Examiner asserts that “Johnson et al. discloses that an authorized user orders paper copies, via the clearinghouse system, wherein the order is processed.” This is not correct. As discussed above, Johnson only teaches that an authorized user may order “rights”, not copies. The Examiner further asserts that “Johnson also discloses an order option, as disclosed in column 10 line 55 is a request that copies (i.e. paper copies) be supplied.” This is not correct. At line 55, Johnson teaches that the user interface provides to the licensee a determination whether or not authorization may be given, “along with price information and an order option.” The order option is an option to order an authorization (a “right”), not an option to order copies.

The Examiner argues her reading of Johnson is supported by the fact that Johnson mentions that educational institutions make copies of documents to create course packets. This fact reported by Johnson does not support the Examiner’s position. It does not suggest or teach that the clearinghouse server system should allow users to place orders for copies of works authorship or that the server system should deliver ordered copies of works of authorship.

The Examiner acknowledges that Johnson does not disclose that the central server system sends a copy to a printer. The Examiner’s position is that this improvement over Johnson is obvious because Johnson teaches that the prospective licensee can place an order for copies. As discussed above, a correct and careful reading of Johnson shows that Johnson does not teach that the prospective licensee can place an order for copies but rather that the prospective licensee can only place an order for “rights”. Therefore, because element (f) of claim 128 includes “the clearinghouse server system sending to a printer a copy of the work of authorship for printing on paper and delivery”, this claim as examined by the Examiner is allowable over Johnson.

In addition, although the applicant maintains that it is unnecessary for patentability, the applicant has added an additional limitation to element (e) which also

distinguishes over Johnson. This element is that the server system also receives a "request" "that a paper reprint be delivered." This additional limitation also distinguishes over Johnson. The same limitation has been added to claim 142.

With these two limitations that distinguish Johnson, claims 128 and 142 are allowable and should be allowed at this time, along with the claims that depend from them. The applicant has added an additional dependent claim to each of them ,new claims 146 and 147.

Independent method claim 129 and the corresponding system claim 145 stand rejected under §103 as obvious in view of Johnson. The Examiner correctly points out that, to modify the Johnson system so that claims 129 and 145 read on the system, one would merely have to change the security settings to allow anyone to access the records in the database. However, the mere fact that it is easy to change the Johnson system so that it is described by claims 129 and 145 does not make it obvious to do so.

Johnson unequivocally teaches away from the inventions specified by claims 129 and 145. In column 3 at lines 48 - 50, Johnson states that the "rights holders themselves" may add, delete, and edit information on the rights management side of the system." Johnson shows a user interface for allowing the rights holders to make these changes in figure 6. As shown in figure 6, a person with access to the system can change the price to be charged and can change whether or not rights may be granted. If any person with a computer having network access could make these changes, this would entirely defeat the purpose of the Johnson system. Thus, there is no teaching in Johnson which provides a suggestion or motivation to make the change to the Johnson system suggested by the Examiner.

Independent method claim 129 and the corresponding system claim 145 should be allowed at this time.

Independent method claim 126 and the corresponding system claim 138 stand rejected under §103 as unpatentable over Johnson in view of Holmes. All of the argument above with respect to claim 128 applies here with respect to claim 126. Not one of the paragraphs of Johnson cited by the Examiner teaches that a licensee can

request or place an order for any kind of copy or that, in response to such a request or order, a copy might be delivered, either electronic or on paper.

In the middle of page 8, the Examiner asserts that Johnson teaches that “as a consequence of having received the message indicating acceptance of the offered terms, allowing the third computer via the network access to an electronic copy of the first work of authorship”, citing figures 2 and 7, column 3 lines 25 - 55, column 4 lines 55 - 67, column 7 lines 1 - 10 and 40 - 55, column 9 line 35, column 10 line 15 and column 10 lines 40 - 60. This is incorrect. Johnson does not teach that the third computer might be allowed access to an electronic copy as a consequence of having indicated acceptance of the offered terms.

As discussed above, figure 7 does not teach that an electronic copy of the work of authorship will be provided to the third computer as a consequence of having indicated acceptance of the offered terms. Figure 7 merely shows a user interface where the prospective licensee must specify whether the use to be made by the prospective licensee will be on paper or electronic. The system in Johnson assumes the user either already has access to an electronic copy of the work or will obtain access by other means.

In column 3 at lines 25 - 37, Johnson discusses the party table and the order table and says nothing about electronic copies. In column 3 at lines 38 - 47, Johnson says nothing about electronic copies. In column 3 at line 48 - 55, Johnson says nothing about electronic copies of the works of authorship.

In column 4 at lines 55 - 67 Johnson says nothing about delivering electronic copies of works of authorship. In column 7 at lines 1 - 10 Johnson states that the types of works for which copyrights might be licensed and managed by the system include works that may be embodied in electronic copies. However, Johnson says nothing about delivering electronic copies of those works to licensees.

In column 7 at lines 40 - 55 Johnson states that the right requested by a licensee might be the right to make electronic copies of works of authorship. However, Johnson says nothing about delivering electronic copies of those works of authorship to licensees.

In column 9 at lines 35 - 55, Johnson states that the right ordered might be the right to make electronic copies of the work. However, Johnson says nothing about

allowing the licensee access to an electronic copy of the work. In column 9 at lines 55 - 65 Johnson says nothing about providing access to works of authorship to licensees. In column 9 line 66 through column 10 line 15 Johnson says nothing about providing access to electronic copies of the works of authorship.

In column 10 at lines 40 - 60, Johnson says nothing about allowing licensees access to electronic copies of works of authorship.

Thus, the Examiner's premise about what is disclosed by Johnson is incorrect.

However, that the Examiner's reading of Johnson is incorrect does not dispose of the issue. The Examiner asserted invalidity under §103 citing Johnson and Holmes (US 6,119,108). Thus, the inquiry turns to whether, given a proper reading of Johnson, Holmes nevertheless provides the missing elements and there is a motivation or suggestion to combine the elements of the two references. The discussion below will show that the missing elements are not provided by Holmes. In fact, even if the Examiner's reading of Johnson is correct, the missing elements are still not supplied by Holmes.

Holmes discloses a system in which copyright protected works of authorship are first downloaded across the network to a client computer and then, when a user attempts to use the work, the user's computer is directed to a licensing web page where the user must conduct a payment transaction to acquire a license. When the license is granted, a server on the network provides information which allows the work of authorship to be used. Thus, Holmes teaches that the work is downloaded before a license is granted or even requested.

By contrast, element (e) of claim 126 specifies that a copy of the work of authorship is not provided across the network until after the user has accepted the terms of an offered license. That is the essential point of claim 126. The electronic copy that is provided to the licensee after the licensee has received the authorization comprising the license is a desirable item of property that the server system provides as part of the consideration for the user having provided consideration via the licensing web page. For example, the licensee may already have a copy of the work of authorship in one formatting of the text and may wish to acquire a copy of the document in a different formatting.

The fact that the Holmes system provides the work of authorship before the license is purchased and not after is made clear by several passages in Holmes. In column 2 at lines 23 - 38, Holmes states that, "Upon receipt and initial access of the encoded electronic object, the executable instructions automatically initiate communication between the user system and the purchasing authority system to conduct a financial transaction between the user system and the purchasing authority system". Holmes further states in column 3 at lines 23 - 29: "When a user attempts to open the object, the executable file interrupts access to the object and automatically establishes a communication link between the user and the purchasing authority system to conduct a financial transaction between the user and the purchasing authority system (thereby perfecting a proper payment and/or license of the object from the owner of that object to the user)". Similarly, in the last line of column 4 continuing into the top of column 5, Holmes states that that the license is transacted only "Once download of the sealed electronic object requested by the user is completed". In the first full paragraph in column 2 Holmes states that a reason for the system working this way is to make these works readily available and encourage users to pass along copies of the works to others.

This is quite different from what is claimed in claim 126. In claim 126, the electronic copy is not made available until a license has been purchased. Thus, Holmes teaches away from the crucial element of claim 126 while Johnson is entirely silent on the crucial element of claim 126. Thus, combining Holmes with Johnson would not produce the system specified by claim 126 or its corresponding system form claim, claim 138. For this reason, claims 126 and 138, and the claims which depend from them should allowed at this time.

Claims 134 and 135, which depend from claim 126, are independently allowable for additional reasons. Claim 134 specifies that the delivered electronic copy includes a network address of a web page containing an indication verifying that the copy was made with permission of an owner of copyrights in the first work of authorship. This is not taught by Johnson or Holmes. In Figure 2, Holmes teaches that a legend may be added to the document stating that it has been properly licensed. However, this legend does not include a network address of a web page containing such information.

Claim 135 specifies that the electronic copy of the document includes a hot spot which takes a person to the web page describe in claim 134. Neither Johnson nor Holmes teaches any such hot spot.

Although the applicant maintains that it is unnecessary for patentability, like the amendment to claim 128, the applicant has added an additional limitation to element (e) of claims 126 and 138. This element is that the server system also receives a "request" "that an electronic copy be delivered".

Respectfully submitted,

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